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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,941	01/03/2002	Carolyn Jean Cupp	112701-330	7917
29157	7590	12/01/2004	EXAMINER	
<b>BELL, BOYD &amp; LLOYD LLC</b> P. O. BOX 1135 CHICAGO, IL 60690-1135				HENDRICKS, KEITH D
ART UNIT		PAPER NUMBER		
1761				

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/037,941	CUPP ET AL.
	Examiner	Art Unit
	Keith Hendricks	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 30 August 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                          |                                                                             |
|--------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                         | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .                                              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                          | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 30, 2004, has been entered.

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: as best as can be ascertained, the claim limitation of the pet food having a "length that is greater than the thickness" does not appear in the specification. Thus, currently, the specification does not properly support the claimed subject matter. However, as this language was found in originally filed claim 1, among others, amendment of the specification would not constitute new matter.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-12, 18, 20, 25, 27, 28, and 30-33 remain rejected under 35 U.S.C. 102(b) as being anticipated by Collings et al. (EP 0 645 095). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed August 30, 2004, have been fully considered but they are not persuasive. At page 8 of the response, applicant states that "nowhere does Collings disclose or suggest the combination of specific density and dimensional characteristics as defined in claims 7, 18, 20, 25, 28 and 31."

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This is not deemed persuasive for the reasons of record. Again, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Further, they do not show how the amendments avoid such references or objections. Applicant has provided no logic or data to support their conclusionary statement, whereas the previous Office action has both clearly addressed this issue and provided logical support for the conclusions therein.

Furthermore, regarding the issue of "a thickness of at least 12 mm and a length that is greater than the thickness", it is noted that no third dimension is provided, either in a relative proportion or as a specific amount. This is important to note because given only two dimensions, "length" and "thickness" (or depth), these may be interpreted in multiple ways, depending on the viewed perspective of the dried pet food. In one view, one may perceive a thickness/depth, but turned on its side, what was previously the "thickness" may now be its width. The longest dimension would always be the length, while the other two dimensions would be open to interpretation with regard to perspective of width or depth/thickness. While See the explanation given in the Advisory Action of July 30, 2004. As previously stated on the record, Collings et al. state that "the extruded strand swells upon exiting the die due to flashing of moisture to steam producing an expanded structure. The strand is cut into 46 to 55 mm lengths of pieces or chips" (pg. 5, ln. 8-10) and is then further dried. The top of page 6 of the reference states that the extrudate was produced "in the form of an expanded strand 50.1 mm in length, 25 mm in width and 9 mm in depth. The strand product swelled upon issuing from the die... [and] was cut into 10 mm thick wavy-shaped chips." Given the scenario described above, however, without the recitation of a measurement for all three dimensions, the referenced teaching of "50.1 mm in length, 25 mm in width" may reasonably be interpreted as having "a thickness of at least 12 mm and a length that is greater than the thickness", wherein the width is viewed as the thickness.

At page 9 of the response, applicant states that

Indeed, the primary focus of Collings relates to an extruded dog food product that has improved resistance to breakage upon shipping and handling. See, Collings, p.2, lines 5-6. Clearly, this suggests that Collings fails to recognize any improved dental cleaning properties from the pet food disclosed therein, let alone, such properties that are due, at least in part, to specific characteristics of the pet food, such as the combination of density and dimensional characteristics as claimed and discussed above.

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This is not deemed persuasive for the reasons of record.

In response to applicant's argument, the fact that applicant may have recognized another advantage which would flow naturally from following the teachings of the prior art cannot be the basis for patentability when the differences would otherwise be obvious, or in the instant case, inherent. Applicant appears to be stating that, although the product of Collings et al. provides improved resistance to breakage on shipping and handling, this would somehow not translate to improved resistance to breaking upon chewing by a pet. This is not a logical conclusion, and has no basis within the reference or the state of the art at the time the invention was made. Applicant has utilized the phrase "improved dental cleaning properties" in their arguments, which is not found in the claims. In fact, however, applicant's own specification, at the top of page 9, states that "being of a low density, the foam [i.e. claimed product] absorbs tooth pressure without splintering and/or crumbing during the chewing process." Thus, regardless of the source of the external pressure applied to the product, be it a shipping package material or a pet's teeth, the same properties (a) are present and inherent, and (b) would be the result of the same components and overall structure within both the claimed and referenced products.

Thus and again, although the reference does not specifically disclose every possible quantification or characteristic of its product, including density data, the density of the product would have been within the instantly-claimed range of "about 16.8 lbs/ft<sup>3</sup> to about 20 lbs/ft<sup>3</sup>", absent any clear and convincing evidence and/or arguments to the contrary. The reference discloses the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of ordinary skill in the art would recognize that the product density, among many other characteristics of the referenced product, would have been an inherent result of the product disclosed therein. Similarly, regarding instant claims 28 and 31-33, the resultant texture of the extruded product would also have been an inherent result of the disclosed product, based upon the same starting materials and methods of production. Furthermore, at page 5 the reference states that the "plasticized food" component "swells upon exiting the die due to flashing of moisture to steam producing an expanded structure" (lines 8-9). This process is similar to that found in the production of cheese puffs, which also expand upon exiting the heated extruder through a constrictive exit passageway, and also contain pockets of air and circular pores as a result of this process. The Patent Office does not possess the facilities to make and test the referenced product, and as a reasonable reading of the teachings of the reference has been applied and does anticipate the instant claims, the burden thus shifts to applicant to demonstrate otherwise.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-17, 19, 21-24, 26 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Collings et al., in view of Hand et al. (US PAT 5,431,927). The references and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed August 30, 2004, have been fully considered but they are not persuasive.

At page 10 of the response, applicants allege that "what the Patent Office has done is to rely on hindsight reasoning in support of the obviousness rejection. Indeed, the Patent Office even admits that Hand and Collings relate to different types of pet foods. See Office Action, page 4. Why then would one skilled in the art be inclined to combine or modify the alleged teachings of same to arrive at the claimed invention?"

This is not deemed persuasive for the reasons of record. Initially, at no point did the Office "admit that Hand and Collings relate to different types of pet foods." Applicant's reference to page 4 of the Office action is assumed to be from the first office action of July 30, 2004, where it is specifically stated that "Hand et al. provides a similar pet food product" to that of Collings et al. Applicant has provided no basis for their statement.

Further, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Simply stating that the applicant does not "believe that the Patent Office can rely solely on Hand to remedy the deficiencies of Collings", is insufficient to rebut the rejection, and the issues and facts addressed therein. Applicant's claimed invention is disclosed by Collings et al., save for the specific dimensions recited in the instantly-rejected claims. However, the selection of a particular size for a pet food piece would not have involved an inventive step for one of ordinary skill in the art. There are hundreds of such products available on the market whereby the ordinarily-skilled artisan could draw inspiration. In fact, the dimensions provided by

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Collings et al. differ only in that of thickness, and even then only by a mere 2mm (10 mm disclosed, versus the instantly claimed 12 mm minimum). Applicant would not be entitled to a patent for simply choosing to provide the same pet food product having a thickness of only 2mm more than that of the reference. It is noted that the teachings of Collings et al. allow for modifications to be made, and that the specific dimensions recited are in the examples. Just as applicants are not limited to their examples for support, neither is the reference. The Hand reference is provided to demonstrate that other similar pet food products were well known in the art, and were produced having the same dimensions as instantly claimed. Given this, it would have been obvious to one of ordinary skill in the art to have provided the pet food product of Collings et al. having the instantly claimed dimensions, absent any clear and convincing evidence and/or arguments to the contrary. Applicant has not demonstrated a patentable distinction or criticality to the extra 2mm in thickness. It is noted that this would not be expected to relate to the "improved dental cleaning properties" as applicant alleges, nor would it materially affect the density of the product.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- i) Claims 1-33 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/154,646.
- ii) Claims 1-33 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/052,949.

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iii) Claims 1-33 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/936,672.

Applicant's arguments filed August 30, 2004, have been fully considered but they are not persuasive. At page 10 of the response, applicant states that they plan to file a terminal disclaimer in the future. However, this is not sufficient to remove the rejections, and thus they are maintained for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KEITH HENDRICKS  
PRIMARY EXAMINER